



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

35

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/779,767

Applicant(s)
Zaghouni

Examiner
Patrick Nolan

Group Art Unit
1644



☒ Responsive to communication(s) filed on Oct 23, 2000

☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 4, 6, 9, 11-21, 24-27, 29-70, and 72-75 is/are pending in the application.

Of the above, claim(s) 12-21, 25, 30-65, and 75 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

☒ Claim(s) 4, 6, 9, 11, 24, 26, 27, 29, 66-70, and 72-74 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 27 and 34

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. Claims 4, 6, 9, 11-21, 24-27, 29-70, 72-73 and newly added claims 74-75 are pending. Claims 12-21, 25 and 30-65 and newly added claim 75 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

2. The request filed on 10-23-00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/779,767 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 4, 6, 9, 11, 24, 26, 27, 29, 66-70 and 72-73 and newly added claim 74 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bona et al. (U) in view of Kuchroo et al. (U), all of record, for reasons stated in Paper Nos. 21 and 26.

Applicant's arguments filed 10-23-00 have been fully considered but are not found persuasive.

The declaration under 37 CFR 1.132 filed 10-23-00 is insufficient to overcome the rejection of claims 4, 6, 9, 11, 24, 26, 27, 29, 66-70, 72-73 and 74 based upon Bona et al., in view of Kuchroo et al., under 35 USC 103 as set forth in the last Office action because:

The evidence supplied in the declaration is not a showing of unexpected results. Furthermore the newly amended claims recite "thereby inactivating T cells for an extended period of time". The new functional limitation whose metes and bounds are entirely unclear leaves the examiner to read the limitation as broadly as is reasonable. The prior art combination would have reasonably expected to inactivate T cells for an extended period of time. The prior art however, would not have reasonably predicted to prevent T cell activation as recited on page 16 of the specification.

To further clarify the record the Examiner did not intend to communicate to Applicant that the prior art combination would not suggest the inactivation of T cells over an extended period of time. The Examiner was trying to communicate to Applicant that if his invention had an unexpected result that his original specification had written support for, the claimed invention would be held non-obvious.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4, 6, 9, 11, 24, 26, 27, 29, 66-70 and 72-73 and newly added claim 74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has no written support in the originally filed claims or specification for the phrase "thereby inactivating T cells for an extended period of time."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 9, 11, 24, 26, 27, 29, 66-68, 70 and 72 are rejected under 35 U.S.C. § 102(a) as being anticipated by Liu et al. (A on the IDS of 6/8/00).

Liu et al, teaches Applicant's construct in a pharmaceutical composition wherein said construct inactivates T cells over an extended period of time (see Figure 1 and 6 in particular).

The prior art teachings anticipate the claimed invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

7. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Patrick J. Nolan

Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
March 20, 2001